DETAILED ACTION

Election/Restrictions

1. Applicant's reply filed on January 31, 2008 traversed of withdrawal of new claims 31-34 as being drawn to a nonelected invention is acknowledged. The traversal is on the ground(s) that search and examination of claims 31-34 can be made without serious burden. This is not found persuasive because the process for using the product as claimed can be practiced with an implant that is not specific as to the retained area of GSS on the implant and the structure of the surfaces of the product claims. The requirement is still deemed proper and is therefore made FINAL.

2. Newly submitted claim 35 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 35 is directed to a species that is distinct from the previously elected invention originally claimed. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 35 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18-27, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Albrektsson et al. (5,702,473). Albrektsson et al. disclose an implant 1 comprising an outer

surface having a first cross-section diameter, capable of being configured to approximately equal bone hole, an inner surface having a second cross-section diameter configured to be smaller than the first diameter, growth stimulating substance (column 4 line 2) retained on the implant and a space defined by the outer surface and inner surface and hole to which it would be implanted. The outer surface is configured as outer crest portions of a screw thread and the inner surface configured as inner portions of a screw thread (column 2 line 28), and the screw thread extends along a majority of the circumference of the implant. Patentable weight is not given to the intended use of the implant in a bone; however, the implant is capable of use in cooperating with the formed bone hole as claimed, being implanted by pressing force (column 1 line 66), and use in a procedure with CT-scan measurement. The implant comprises a recess 8, wherein the GSS is disposed within the recess. The recess is configured to be at least part longitudinally along and at least part circumferentially around the implant. The implant comprises a porous oxide layer disposed on the implant (column 2 line 49), as it is known that blasting with titanium or aluminum oxide forms a porous surface and thin oxide layer.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Albrektsson et al. in view of Caplan et al. (4,620,327). Albrektsson et al. disclose an implant that shows the limitations as described above; however, they do not show the GSS adapted and provided in gel

form. Caplan et al. teach a GSS in gel form (column 3 line 31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the implant of Albrektsson et al. by providing the GSS of Caplan et al. for improved bone formation in view of Caplan et al.

Response to Arguments

7. Applicant's arguments filed January 31, 2007 have been fully considered but they are not persuasive. It is noted that Applicant's own definition of the terms are applied such as "configured to be at least approximately equal to the cross-section diameter of the bone hole" can be 5 to 20% greater than the cross-sectional diameter of the bone hole, which means the outer diameter is actually larger by as much as 20% than the bone hole to which it is to be implanted. Also, the outer surface and inner surface can be different portions of the same surface as shown in Applicant's figures. The claimed limitations do not limit the difference in first cross-section diameter and second cross-section diameter which Applicant argues. It is believed that there is space, as it is occupied by GSS, to separate the outer surface and inner surface from the bone to which the implant is to be implanted.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melba Bumgarner whose telephone number is 571-272-4709. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Melba Bumgarner/
Primary Examiner, Art Unit 3732